



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,275	11/26/2003	Douglas Allard	11533.0028.NPUS00	8914

27194 7590 11/20/2007
HOWREY LLP
C/O IP DOCKETING DEPARTMENT
2941 FAIRVIEW PARK DRIVE, SUITE 200
FALLS CHURCH, VA 22042-2924

EXAMINER

CECIL, TERRY K

ART UNIT	PAPER NUMBER
----------	--------------

1797

MAIL DATE	DELIVERY MODE
-----------	---------------

11/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/724,275	Applicant(s) ALLARD, DOUGLAS	
	Examiner Mr. Terry K. Cecil	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,12-19,21-30,32 and 34-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-8, 10, 12-19, 21-30, 32, 34-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

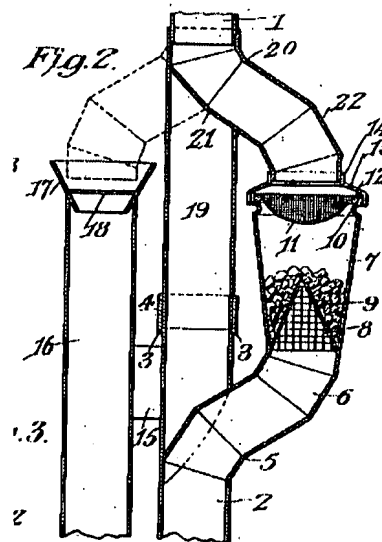
A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-7, 10, 12-16, 18-19, 21-26, 28-30, 32, 34-37 and 39-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (U.S. 0,971,578). Walker teaches a filter



apparatus for filtering rainwater e.g. the roofs of buildings. As shown in the figures, three paths through the apparatus are provided. The conducting and guiding spout acts as a valve that is moved to determine the flow route therethrough. The first flow route 6 includes a plurality of filters (8, 9, 11) wherein 11 is basket-shaped and 11+12 is removable and is considered to be a "cartridge". The second route 19 (a bypass) delivers water the same outlet as the first route. A third route (16) also includes a

Art Unit: 1797

removable filter (17+18) and delivers flow to a second outlet.

3. Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Pinto (U.S. 2,419,501). Pinto discloses a filter apparatus for filtering water in flow through a downspout (figure 1). The removable basket filter is considered a filter cartridge. When flow through the basket becomes impeded, figures 4 and 5 are configured such that flow is bypassed around the basket and directly to the same outlet 12.

4. Claims 1, 3, 5-7, 10, 12, 19, 21, 23, 29, 30, 32, 34, and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Batt, Jr. (U.S. 2,532,388). In Batt by virtue of the spacing between the filter cartridge 21 and the inner surface of the casing, water can bypass the filter and flow directly to the outlet (col. 2. lines 45-49).

5. Claims 1, 3, 5-7, 10, 12-14, 19, 21, 23-24, 28-30, 32, 34-35 and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Trump (U.S. 3,465,885). In trump when removable basket filter cartridge 23 becomes clogged, all flow is directed to an alternate route to flow through 24 to the same outlet 22. When 24 becomes clogged, all flow is directed to yet another alternate route to flow through outlets 33 (figure 1).

Claim Rejections - 35 USC § 102/103

6. Claim 8 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over any of the above prior art references. The references teach a

Art Unit: 1797

product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. The way in which the filter apparatus is added to the downspout—e.g. removing a section of pipe and replacing with apparatus—is a product-by-process limitation. The examiner contends that the resultant product is the same as those known above or at least an obvious variant thereof. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 17, 27 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the above prior art references in view of Macpherson et al. (U.S. 6,821,427). These claims add the limitation of chitosan. Macpherson teaches a chitosan gel for treating stormwater. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the

Art Unit: 1797

invention to have the chitosan of Macpherson in any of the aforementioned downspout filters, since Macpherson teaches the benefit of reducing the amount of contaminants in stormwater.

Response to Arguments

9. Applicant's arguments filed 9-4-2007 have been fully considered but they are not persuasive.

- Despite applicant's remarks to the contrary the first two flow routes (shown in *full lines* in figure 2) of Walker still intersect at the same outlet pipe 2. Applicant seems to be confusing the outlet with the destination (e.g. different containers placed below the pipe 2). Page 1, lines 34-37 clearly state that the full lines of figure 2 show water flow directed to a cistern (while the dotted lines show the route to the sewer). It is also clear from page 1, lines 58-65, that elbow 5 permits the flow of water *into the pipe 2*. Page 1, lines 47-50, clearly state that the pipe which leads to the cistern has at *its upper end* a shoulder 3. It is this shoulder that connects with post 19 to receive water from the roof (see figure 1). The partition of page 1, lines 50-58 argued by applicant merely deflects the water to prevent filtered water from flowing upstream toward 3 but does not prevent flow through pipe 2 when in the configuration as shown in e.g. figure 1. In summary, water flowing through elbows 5 and 6 (first route) flows through the outlet pipe 2 and likewise, water flowing through 19 (second route) also flows through the outlet pipe 2 to whatever container is placed therebelow. It is also pointed out that even though Applicant argues that Walker does not teach a bypass flow to the same outlet as the first route, claim 40 does not require this limitation; did applicant intend to cancel claim 40?

Art Unit: 1797

- Applicant's remarks regarding Pinto are not convincing. Concerning the limitation of claims 3, 21, 22 requiring a filter cartridge. It was clearly stated in the action, that the basket is considered to be the filter cartridge. As for the limitation of a bypass route such is shown in e.g. figures 4 and 5. There it can be seen that when the basket 21 is full of leaves and is therefor clogged, water would overflow the rim and fall through the area to the right of the basket to the outlet 12. Drawings can be used to anticipate claim limitations, see MPEP 2125.
- Applicant's remarks regarding Batt are not convincing. Batt's teaching that the leaf catching filter is spaced on all sides from the casing, further strengthens the Examiner's assertion that water can bypass the filter on coarse to the outlet, thereby providing a bypass route. Regarding claims 3, 21 and 32, these claims were rejected to the same specificity as that claimed.
- In Trump, even though water initially flows through the basket 23 (first route) and through 24 (primary bypass route) simultaneously, after the basket becomes clogged, the water that would have flowed through the basket is bypassed through 24. Therefor, a bypass route to the outlet exists. As for claims 13 and 28, water passing through outlets 33 is another route (secondary bypass) through the apparatus, albeit a short one.
- Despite being amended, claim 8 is still a product-by-process limitation that fails to further structurally define the apparatus over the references used in the rejection of the parent claims.
- As for the 103 rejection, Macpherson's teaching of reducing contaminants in water before releasing the water into the environment is sufficient reason for combining with the downspout references which also release water into the environment.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

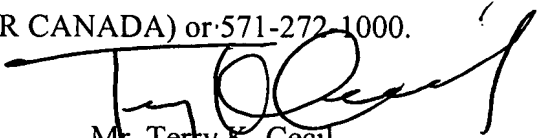
Art Unit: 1797

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Terry K. Cecil whose telephone number is (571) 272-1138.

The examiner can normally be reached on 8:00a-4:30p M-F..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Mr. Terry K. Cecil
Primary Examiner
Art Unit 1797

TKC